

Docket No.: AUS-1828-AL

REMARKS

5 Claims 3, 4, 6-13 and 26-37 are pending in the application. By this Amendment, claim 12 is amended. The claim amendment does not introduce new matter as it is fully supported by the specification. Applicants note with appreciation that claims 3, 4, 6-11 and 26-37 are allowed. Applicants respectfully request reconsideration of claims 12 and 13 in view of the above amendment and the following remarks.

10 Claims 12 and 13 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,055,874 to Brown. Applicants respectfully traverse this rejection because Brown does not disclose each and every feature of the claimed invention.

To be anticipating, a prior art reference must disclose each and every limitation of the claimed invention, the prior art reference must be enabling, and the prior art
15 reference must describe the claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention. Helifix Ltd. v. Blok-Lok, Ltd., 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000). Moreover, a person of ordinary skill in the art must be able to obtain the claimed invention from the alleged prior art reference without an undue amount of experimentation. Id. The level of
20 ordinary skill in the art is based on the type of problems encountered in the art, the prior art solutions to those problems, the rapidity with which innovations are made, the sophistication of the technology, and the educational level of workers in the field. Id.

Even if the claimed invention is disclosed in a prior art reference, that prior art reference will not suffice as prior art if it was not enabling. In re Donohue, 766 F.2d
25 531, 226 USPQ 619 (Fed. Cir. 1985). That is, a reference must enable someone to practice the invention in order to anticipate under 35 U.S.C. §102(b). Symbol Technologies, Inc. v. Opticon, Inc., 935 F.2d 1569, 19 USPQ2d 1241 (Fed. Cir. 1991).

The claimed invention, as amended in claim 12, is directed to a surgical clip having a sliding state and a crimped state, the surgical clip being adapted for use in a
30 surgical procedure initially to slide along suture ends to an operative position and ultimately to crimp the suture ends at the operative position. The surgical clip

Docket No.: AUS-1828-AL

comprises a substrate bendable between the sliding state and the crimped state, the substrate being formed from a first bio-compatible material having a first coefficient of friction with the suture ends; a first coating carried by the substrate to form a first layer of second bio-compatible material on the substrate; the second bio-compatible material of the first layer forming a barrier between the suture ends and the substrate, the barrier being adapted to inhibit contact between the suture ends and the substrate when the clip is operatively disposed on the suture ends; the second bio-compatible material of the first layer having properties for engaging the suture ends with a second coefficient of friction greater than the first coefficient of friction to facilitate traction between the suture ends and the clip in the crimped state, wherein the material of the first layer includes plastic. (Emphasis added.)

Applicants respectfully submit that Brown is directed to a different invention in a different art (a paper clip for clampingly engaging two sheets of paper), that Brown is not enabling to a person of ordinary skill in the art of the claimed invention (surgical clip), that one of ordinary skill in the art of the claimed invention could not have possibly obtained the claimed invention from Brown without an undue amount of experimentation (forming the substrate with one bio-compatible material and coating the substrate with a second bio-compatible material would certainly require a lot of experimentation), and that Brown does not sufficiently describe the claimed invention to have placed the public in possession of it. Thus, Brown does not anticipate claims 12 and 13 under 35 U.S.C. §102(b).

For at least the above reasons, Applicants respectfully submit that Brown does not anticipate claim 12 and its dependent claim 13 under 35 U.S.C. §102(b).

Claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over Brown, and claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over Brown in view of U.S. Patent No. 5,179,765 to Sungberg. Applicants respectfully traverse these rejections because Brown does not disclose the claimed invention.

As stated above, Brown is directed to a different invention. In particular, Brown discloses a paper clip for clampingly engaging two sheets of paper. The Examiner

Docket No.: AUS-1828-AL

asserts that "[a]lthough the clip is intended to attach paper, it may also be used to attach suture." Claim 12 (as amended) recites, among other features, a surgical clip having a bio-compatible coating for engaging the suture ends, the coating having a greater coefficient of friction than the bio-compatible substrate of the clip. As such, applicants respectfully submit that the application of a paper clip, i.e., for office use, and the application of a surgical clip are totally different and are not interchangeable. In addition, one of ordinary skill in the art of the claimed invention could not have possibly obtained the invention from Brown without an undue amount of experimentation, i.e., forming the substrate with one bio-compatible material and coating the substrate with a second bio-compatible material would certainly require undue experimentation. Sungberg is also directed to a paper clip and there is no indication or suggestion that it could be combined with Brown to arrive at the claimed invention. Stated another way, the prior art references both relate to paper clips that are structurally and functionally different from the claimed surgical clip of the invention that would have required one skilled in the art of surgical clips to expend an undue amount of experimentation to study Brown and Sungberg, either alone or in combination, to arrive at the claimed invention. Even if were possible to combine Brown and Sungberg, there is no suggestion to do so. For at least the above reasons, applicants respectfully request withdrawal of the rejections of claims 12 and 13 under 35 U.S.C. §103(a).

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



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